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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,075	06/02/2000	Thomas J. Shafron	694231/004	7301

7590

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EXAMINER

VU, TUAN A

ART UNIT	PAPER NUMBER
2124	

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/587,075

Applicant(s)

SHAFRON, THOMAS J.

Examiner

Tuan A Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-6, 8-10, 12-13, 15, 17-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5-6, 8, 12, 13, 15 and 17-19 is/are allowed.
- 6) ☒ Claim(s) 9, 20-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) ✓
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10, 13.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 14.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the Applicant's response filed 12/29/2003.

As indicated in Applicant's response, claims 1-3, 5-6, 8-10, 12-13, 15, 17-20, 22-24, 26-31, 33-34, 36-41, 43-45, and 48-50 have been amended and claims 4, 7, 11, 14, 16 canceled and claims 1-3, 5-6, 8-10, 12-13, 15, 17-50 are pending in the office action.

Claim Objections

2. Claim 3 is objected to because of the following informalities: there appears to be missing connecting conjunctions in the phrase 'wherein step passing the needed group ...'.
3. Claim 5 is objected to because of the following informalities: the limitation "links to the needed group of resources to loading text strings and image data into a memory ... to thereby produce a modified ... of the downloadable toolbar application ... image data" (lines 3-6 of claim) seems to have a incongruous verb action phrase in "links to the needed group... to loading text strings and image data ..." and should be corrected to become, for example – links to the needed group of resources whereby to perform the loading of text strings -- . Further, this limitation appears to be a run-on sentence and needs to be re-structured so as to become less overloaded.
4. Claim 8 is objected to because of the following informalities: the phrase "upon installation" (line 4-5) appears to have been inserted without connection to the flow of the whole sentence, and should be restructured for example as – ; and upon installation, a toolbar interface of the downloadable --. Likewise, the introduction of limitation 'a toolbar interface of the downloadable toolbar application becoming ... user interface' (lines 5-6) needs to be re-structured syntactically to flow with the rest of the claim as well; one suggestion being – a

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toolbar interface of the downloadable toolbar application being integrated within the browser application user interface ...--, for example.

Further, the verb action of “exhibit” (line 10) needs to be – exhibits -- to grammatically accord with the subject ‘application’.

5. Claim 15 is objected to because of the following: there seems to be a missing ‘a’ before “software implemented resource manager operative ...” (line 10). Also, there is a extraneous “ _ ” between ‘system’ and ‘comprising’ (line 5)

6. Claim 20 is objected to because of an extraneous ‘application’ in ‘An application toolbar application’ (line 1).

7. Claim 27 is objected to because there is a spelling mistake in ‘intergrated’ (line 7).

8. Claim 30 is objected to because there is a missing ‘-’ between ‘client’ and ‘server environment’ on line 3.

9. Claims 37, 41, and 45 exhibit the same missing ‘-’ (line 2) for ‘client server environment’.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 9, 20-22, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the software application" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim; and should be corrected to become, for example, -- the downloadable toolbar application.

Claim 20 recites the limitation "the client-server system" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Further in claim 20, the limitation 'in response to a second user with a language preference different from the first user's language preference logging in to use the toolbar application...' (lines 13-14) does not clearly define whose login it is or what is being logged in order to use the toolbar application. Examiner would interpret that the preference that has been used by a first user, such user having logged in to use the toolbar application.

Claim 21 also recites the 'client-server system' as mentioned in claim 20.

Claim 22 as a whole is unclear because it fails to describe how the method recited as "modifying a toolbar interface ..." is being implemented in view of the limitations described in steps (a) to (e). There is a lack of relationship between what is recited in the preamble as the desired method and the structural steps to achieve that method, i.e. the claim should provide at least one or more actions as to generate a result consistent with the context and purpose of the method claimed in the preamble. Correction is required so as to provide some step actions so as to put across the concept recited as modifying an interface.

Claim 27 recites the limitation "the client computer" in line 9. There is insufficient antecedent basis for this limitation in the claim.

All the dependent claims to the above rejected claims are also rejected.

Claim Rejections - 35 USC § 101

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12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 22-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The practical application test requires that a “useful, concrete, and tangible result” be accomplished; and an abstract idea when practically applied is eligible for a patent.

Claim 22 recites a method for modifying a toolbar interface but, taken as a whole does not describe the concrete and relevant steps to achieve such claimed method. Hence the claim does not fulfill the statutory requirement that in order to make an invention as claimed step actions have to be provided to achieve a concrete, tangible and useful result. The steps described in the claims do not amount to achieving the purpose of modifying a toolbar interface. Absent some useful and concrete result specific to the claimed method, the invention fails to be statutory.

Claim 27 recites a method of increasing the desirability of a web site having some steps to retrieve resources into a browser application interface to generate a toolbar interface. The steps to provide some concrete results are depicted in a useful art but there is lack of a tangible element as to enable such result to be implemented in, for the method as claimed remains abstract. In other words, the claim does not satisfy the statutory requirement that an invention is to have steps to achieve a concrete, tangible and useful result. A suggested correction would be to amend the method of line 1 to become – computer-implemented method.

Claim 30 also recites a method that is accomplished through some concrete steps to achieve some concrete result (notwithstanding the USC 112/2 rejection from above) but such

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method is not described sufficiently so as to show a tangible element whereby those steps can be implemented. Hence, the claim does not fulfill the statutory requirement of an invention.

Correction as to provide evidence of a tangible form of computer system in which to implement the method is suggested.

Claims 41, 45 and 50 exhibit the same deficiency as claims 27, 30 because these claims do not provide a tangible element whereby to effect the recited step actions in order to achieve the concept of generating a toolbar interface, which omission amounting to a non-statutory status. Correction as to provide evidence of a computer system in which to implement those methods is suggested. For example, claim 50 can be corrected so that in line 2, the 'as part of an Internet browser ... browser application' can be modified to becoming 'as part of an Internet browser interface of an Internet browser application operating on a computer device (or appliance); the toolbar comprising ...'

All the dependent claims to the above rejected claims are also rejected.

Allowable Subject Matter

14. Claims 1-3, 5-6, 8, 12, 13, 15 and 17-19 are allowed.

Pending some minor corrections as objected to from above, claims 1-8 are allowable.

The features allowed are as following:

A method of modifying a toolbar interface operable with (i) a downloadable toolbar application that is integrated into a browser application, such method comprising (ii) receiving into a server system a request to change the toolbar interface based on user preference or a customizable option; (iii) communicating from the server the resources associated with the

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preference parameter or identifier in response to the above request for a change if such resources are not stored locally.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (703)305-7207. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9306 (for formal communications intended for entry)

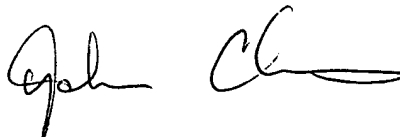
or: (703) 746-8734 (for informal or draft communications, please consult Examiner before using this number)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA. , 22202. 4th Floor(Receptionist).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VAT
February 20, 2004

A handwritten signature in black ink, appearing to read 'John Chavis', with a stylized flourish at the end.

JOHN CHAVIS
PATENT EXAMINER
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